



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,920	04/13/2004	Eric Zitaner	52531.100001 (CON)	3562
7590 W. Scott Petty, Esq. KING & SPALDING LLP 45th Floor 191 Peachtree Street, N.E. Atlanta, GA 30303			EXAMINER WONG, LESLIE	
			ART UNIT 2164	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	DELIVERY MODE
3 MONTHS			12/20/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/822,920

Applicant(s)

ZITANER ET AL.

Examiner

Leslie Wong

Art Unit

2164

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 17-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/04&amp;10/05</u>  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Information Disclosure Statement***

1. Applicants' Information Disclosure Statement, filed 08/11/2004 and 10/03/2005, has been received, entered into the record, and considered. See attached form PTO-1449.

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 17, 23, and 37 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 9, 17, and 38 of U.S. Patent No. 6,741,993 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because

**Claims 1, 9, 17, 23, and 38 of patent No. 6,741,993 contains every element of claims 17, 23, and 37 of the instant application and as such anticipates**

**claims 17, 23, and 37 of the instant application.**

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is **obvious over**, or anticipated by, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 18-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 17, line 15 and claims 20-22 recite the term "operable". The term "operable" is defined as being such that use or operation is possible and one of the definitions of "possible" is of uncertain likelihood. As such, the recitation that an element is "operable" perform a function is not a positive limitation but only requires the ability to so perform.

Claims 18-22 are rejected for fully incorporating the deficiencies of their respective base claims by dependency.

***Claim Rejections - 35 USC § 101***

5. Claims 23-31, 33, and 36 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

Claims 23-31, 33, and 36 are not statutory because they merely recite a number of computing steps without producing any tangible result and/or being limited to a practical application. For example, adding the step of “generating a report...” or the like after the “analyzing...” step in claim 23 would provide a tangible result.

To expedite a complete examination of the instant application the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four categories of invention.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 17-46 rejected under 35 U.S.C. 102(b) as being anticipated by **Havens** (U.S. Patent 5,924,072).

Regarding claim 17, **Havens** teaches a competitive rewards database system (i.e., database 30 in Fig. 1; col. 9, line 29 – col. 10, line 24) comprising:

- a). a competitive reward database operative to receive raw competitive rewards data comprising competitive rewards data for employees of an entity and competitive rewards data from a plurality of sources other than the entity (col. 6, line 62 – col. 7, line 1; col. 7, lines 13-22);
- b). data mapping table for automatically mapping the raw competitive rewards data prior to incorporation into the competitive rewards database by mapping the raw competitive rewards data to benchmarks comprising job function, discipline or scope (col. 5, lines 19-31);
- c). a computer system, coupled to the competitive rewards database via data communications channel, operative to provide the competitive rewards data for employees of the entity to the competitive rewards database on behalf of the entity (col. 3, lines 19-22 and 30-35), and

d). . . a rewards workbench operable to query the competitive rewards database in support of analysis of the mapped competitive rewards data (col. 7, lines 13-22).

Regarding claims 18, 25, and 38, **Havens** further teaches wherein the competitive rewards data for the entity comprises employment data for the employees of the entity, the employment data comprising at least one of base pay data, long term incentive pay data and annual incentive pay data (col. 6, lines 35-43).

Regarding claim 19, **Havens** further teaches wherein the competitive rewards data contains at least one calculated data value (col. 6, lines 44-53).

Regarding claims 20-21, **Havens** further teaches a data capture tool operable to provide remote access to at least a portion of the competitive rewards database and wherein the rewards workbench is coupled to a data network and is operable to provide remote access to at least a portion of the competitive rewards database (col. 4, lines 9-31 and Fig. 1).

Regarding claims 22, 24, and 39, **Havens** further teaches wherein the rewards workbench is operable to automate data feeds from the competitive rewards database to at least one third party human resources management system (col. 7, lines 13-38).

Regarding claims 23 and 37, **Havens** teaches method for administering a competitive rewards database comprising:

a) receiving raw competitive rewards data comprising competitive rewards data for employees of an entity and competitive rewards data from a plurality of sources other than the entity (col. 4, lines 32-51, col. 9, line 29 – col. 10, line 14);

b) automatically mapping the raw competitive rewards data for incorporation into the competitive rewards database by mapping the raw competitive rewards data to benchmarks comprising job function, discipline, or scope (col. 5, lines 36-47 and col. 8, lines 18-63);

c) incorporating the mapped competitive rewards data into the records of the competitive rewards database (col. 5, lines 36-47 and col. 8, lines 18-63); and

d) analyzing the mapped competitive rewards data by performing a competitive rewards analysis for one or more of the employees of the entity (col. 11, lines 21-45; col. 7, lines 13-22).

Claim 37 additionally recites the step of generating a report presenting results of the analysis (col. 7, lines 13-22).

Regarding claim 26, **Havens** further teaches wherein the step of mapping the raw competitive rewards data comprises translating, scaling, reformatting or calculating portions of the raw competitive rewards data for compatibility with the benchmarks (col. 3, line 59 – col. 4, line 20).



Regarding claim 27, **Havens** further teaches the step of using a data capture tool to adjust the mapping of the raw competitive rewards data (col. 4, lines 9-31).

Regarding claims 28 and 40, **Havens** further teaches the step of using a rewards workbench to query the competitive rewards database in support of analyses of the mapped competitive rewards data, the analyses comprising at least one selected from a group comprising evaluation of prevalence of reward practices and plan provisions, comparison of member reward values to specific comparator groups, development of market reference data, model and development of base pay structure, analyses of competitive rewards cost implications, and data mining analyses (col. 7, lines 13-22; col. 3, lines 1-5; and col. 6, lines 5-9).

Regarding claims 29 and 41, **Havens** further teaches the step of using a rewards workbench to automate a data feed between the competitive rewards database and at least one third party human resources management system that is not associated with the entity, thereby supporting a submission of certain mapped competitive rewards data in the form of a survey to the third party human resources management system (col. 3, lines 19-22 and 30-35 and Fig. 3).

Regarding claims 30 and 42, **Havens** further teaches wherein the step of analyzing the mapped competitive rewards data comprises a competitive rewards

analysis, a total compensation planning analysis or a performance-based analysis (col. 7, lines 13-22).

Regarding claims 31 and 43, **Havens** further teaches wherein the step of receiving the raw competitive rewards data comprises receiving the raw competitive rewards data at the competitive rewards database on a periodic basis (col. 7, lines 13-31 and col. 8, lines 12-32).

Regarding claims 32 and 44, **Havens** further teaches wherein the step of receiving the raw competitive rewards data comprises:

    sending a polling signal from the competitive rewards database to a computer system operated on behalf of the entity (col. 8, lines 12-32); and

    responsive to the polling signal, transmitting the competitive rewards data for the employees of the entity from the computer system to the competitive rewards database (col. 8, lines 12-32).

Regarding claims 33 and 45, **Havens** further teaches wherein the data mapping step comprises using a data mapping table to map without manual intervention the raw competitive reward data based on benchmark global job matches (col. 5, lines 19-31).

Regarding claim 34, **Havens** further teaches the step of generating a report in response to completing the analysis of the competitive rewards data (col. 7, lines 13-22).

Regarding claim 35, **Havens** further teaches wherein the step of analyzing the mapped competitive rewards data generates an up-to-date mapping for competitive rewards data of the employees for the entity to at least one of the benchmarks (col. 13, lines 12-20).

Regarding claims 36 and 46, **Havens** further teaches wherein the step of analyzing the mapped competitive rewards data comprises a comparison of the competitive rewards data for the employees of the entity to one of the benchmarks maintained by the competitive rewards database (col. 14, lines 30-65).

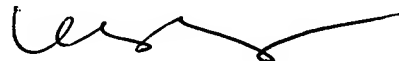
### ***Conclusion***

8. The prior art made of record and not relied upon from PTO-FORM 892 is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie Wong whose telephone number is (571) 272-4120. The examiner can normally be reached on Monday to Friday 9:30am - 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CHARLES RONES can be reached on (571) 272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Leslie Wong  
Primary Patent Examiner  
Art Unit 2164

LW  
December 11, 2006